

### REMARKS

Claims 36-90 have been rejected under 35 U.S.C. §251 as being an improper recapture of surrendered subject matter in the parent application. Particularly, the Office Action asserts that a broadening aspect is present in the reissue Independent Claims 36, 42, 49, 58, 59, and 76 that was not present in the application for patent, and that because the alleged surrendered subject matter relates to the alleged recaptured matter, the unduly narrow scope of the parent claims was not permissible error within the meaning of the reissue statute. Furthermore, the Office Action states that Applicant's reissue oath/declaration is defective because it fails to identify at least one error that is relied upon to support the reissue application.

As to the Office Action's rejection of the Applicant's reissue oath/deflation, please see the amended oath/declaration filed herewith, in which Applicant has cited at least one error in the claims to support the reissue application. Particularly, Applicant has added the following paragraph to the oath/declaration:

I verily believe the original patent to be wholly or partially inoperative by reason that the patent claims less than I had a right to claim in the patent. For example, claims of the original patent are limited to a "device manager". This limitation is not necessary to overcome the prior art if other limitations are included. The attorney prosecuting the original patent added this limitation deliberately, but did so in error. The error arose in the prosecution of the original application which resulted in the issuance of the patent. The attorney prosecuting the original application failed to appreciate the scope of the invention, and thus limited the claims as indicated above. All errors being corrected arose without any deceptive intention on my part. I further acknowledge my duty to disclose information which is material to the examination of the application under 37 CFR § 1.56.

Applicant respectfully asserts that he has fulfilled his obligation under 35 U.S.C. §251 for asserting an error upon that makes the original application wholly or impartially invalid as required under 37 CFR 1.175(a)(1).

In regard to the Office Action's rejection of Claims 36-90 for alleged improper recapture of surrendered subject matter, Applicant respectfully maintains that the Office Action has mischaracterized and misapplied the holdings of the above cases as well as the current state of the recapture doctrine. Specifically, Applicant asserts that the state of the recapture doctrine, when read in view of the intent and wording of 35 U.S.C. §251 does not require reissue claims to be materially narrow in relation to surrendered matter.

Requiring a Reissue Applicant to Materially Narrow a Claim Containing Recaptured Matter in order to Escape the Recapture Doctrine is Counter to the Intent of the Broadening Reissue Statute

Recent cases, such as Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 1371 (Fed. Cir. 2001), have attempted to mask the inconsistencies between 35 USC §251 and the recapture doctrine by requiring the patentee to narrow the scope of a broadening reissue claim in a manner related to what the patentee surrendered during prosecution of the original patent to secure the patent. Similar to the recapture doctrine itself, the "narrowing requirement" has no basis in 35 USC §251, which only requires "error without deceptive intention" as a basis for filing a broadening reissue.

Indeed, if the requirement for obtaining a broadening reissue is "error without deceptive intention"<sup>1</sup>, and a "failure to appreciate the scope of the invention"<sup>2</sup> that results in the patentee "adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims

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<sup>1</sup> 35 USC §251.

<sup>2</sup> see generally, Wilder, 736 F.2d 1516.

patentable over the prior art”<sup>3</sup>, then why should a patentee be compelled to further limit his claim to a scope that is more than what is necessary to overcome prior art?

The narrowing requirement of the recapture doctrine is not only counter to the statute, but it is inconsistent with the intended purpose of the broadening reissue practice announced in earlier cases, such as Battin v. Taggart, 58 U.S. 74 (S.Ct., 1854) and Topliff v. Topliff, 145 U.S. 156 (S.Ct., 1892) – that the inventor should be entitled to claim all he has invented.

Contrary to the statements in Ball Corp. v. U.S., 729 F.2d 1429 (Fed. Cir., 1984), Mentor Corp. V. Coloplast, Inc., 998 F.2d 992 (Fed. Cir. 1993), Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, In re Clement, 131 F.3d 1464, and most recently, Pannu, the narrowing requirement of the recapture doctrine provides little if any protection or predictability to a would-be infringer, because neither the recapture doctrine nor the narrowing requirement necessarily protects the would-be infringer against a patentee pursuing claims containing the recaptured matter. In particular, even though a patent is amended to issue with narrowed claims, the patentee could, and commonly does, file a continuation application to pursue broader claims. The narrowing of the issued claims provide no protection to would-be infringers in this commonplace scenario.

Moreover, the patentee should fear that broadened claims may be obtained by reissue. That is exactly what the statute allows. All members of the public are on notice that a broadening reissue can be filed within two years of the issue date of any US patent. The would-be infringer operating in the two-year broadening reissue window is protected without any equitable recapture doctrine.

The intervening rights protections of 35 USC § 252 explicitly provide the safety net that Congress intended in the situation of a broadening reissue. To find that other equitable

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<sup>3</sup> see generally, Richman, 409 F.2d 269.

protections exist runs directly contrary to Congress' explicit provision of intervening rights in 35 USC § 252. Yet, the recapture doctrine persists, hurting patentees and affording a would-be infringer a very narrow and largely theoretical degree of protection from infringement litigation.

Not only is the recapture doctrine and the requirement that a patentee must narrow his claim in a manner that is necessary to overcome prior art in order to avoid the doctrine not consistent with 35 USC §251 and subsequent case law relating to the scope of "error without deceptive intention", but these requirements, when balanced against the inequities and burden placed on the patentee, afford very little, if any, predictability or protection to a would-be infringer.

### **Conclusion**

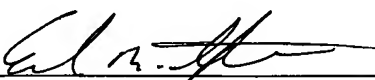
Because the Applicant has committed a permissible error within the meaning of 35 U.S.C. §251, namely, attorney's failure to appreciate the scope of the invention as embodied in the original and parent reissue claims, the removal of the limitation, "virtual device driver", is not barred under the statute.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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Erik M. Metzger  
Registration No. 53,320

12400 Wilshire Blvd.  
Seventh Floor  
Los Angeles, CA 90025  
(408) 720-8300